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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,726	10/04/2001	Mark Thompson	020375-003600US	3054
20350 7590 07/10/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
ALL HATEM M				
ART UNIT		PAPER NUMBER		
3692				
MAIL DATE		DELIVERY MODE		
07/10/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/971,726

Applicant(s)

THOMPSON, MARK

Examiner

HATEM ALI

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 04/11/2006, PROSECUTION IS HEREBY REOPENED. New ground of rejections set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Kambiz Abdi/
Supervisory Patent Examiner, Art Unit 3692

2. The following is an office action in response to the communication received on 4/09/2008.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Patent statute does not allow patents to be issued on particular business systems and method that depend for their operation on human intelligence alone. In case of **claim 1**, a method for processing a financial instrument as electronic package for crediting the presenter for funds is unpatentable as directed to nonstatutory subject matter under 35 U.S.C. §101, since mental processes standing alone are not patentable, even if they have practical applications. **Claims 1-16** can be carried out by mental steps and do not link to any of patentable statutory class. The **claims 1-16**, at issue do not use of machine and does not describe process of manufacture or process for alteration of composition of matter, and since claim instead cover use of mental processes to solve the step of determining financial product in an electronic package for crediting a fund on the basis of input data, and thus seek to patent use of human intelligence in and of itself. As the PTO notes, "[t]he Supreme Court has recognized only two instances in which such a method may qualify as a section 101 process: when the process 'either [1] was tied to a particular apparatus or [2] operated to change materials to a 'different state or thing. Ref: In re Comiskey, 84 USPQ2d 1670(Fed. Cir.2007).

As per **Claims 1-16**, Applicant's specification indicates "It is therefore an object of the present invention to provide an improved method for enabling consumer savings and investment for their future financial security." and the specification failed to disclose any connection of these mental steps to technology for performing alternative process of transaction and personal investment strategies. Since Applicant's

Art Unit: 3692

specification reads on non-statutory subject matter such a rejection is proper.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-16** and **30-38** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Buchanan*** et al (7,216,106) in view of ***Anderson*** et al (2001/0018739).

As per claim 1, ***Buchanan*** discloses a financial instrument, method comprising:
crediting the presenter for funds in accordance with the financial instrument (col.3, lines 53-56; via checks credited to the depositing individual's or organization's bank account).

Buchanan fails to disclose explicitly the step of receiving an electronic package defining an image of the financial instrument at a first institution from a presenter, the image having been generated as part of a transaction at a point of sale.

However, ***Anderson*** being in the same field of invention discloses the step of receiving an electronic package defining an image of the financial instrument at a first institution from a presenter, the image having been generated as part of a transaction at a point of sale_(para 0039-0043 and specifically para 0042, line 1+ point of sale[POS]

devices allow an individual to conduct transaction and **para 0043**, lines 1+; via Check imaging ... banking institution).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the features and disclosures of **Buchanan** to include the disclosures of **Anderson** to facilitate the Electronic Check Presentment[ECP] without routing paper checks at **POS** devices.

As per claim 2, Buchanan discloses that the electronic package comprises the image (**col.2**, lines 10-21; via collection of funds by processing electronic images of items implied electronic package of images for clearing checks).

As per claim 3, Buchanan discloses the image is stored at a location within a depository and the electronic package comprises a reference to the location (**col.2**, lines 34-55; via storing and item numbering information or unique number information back and forth [line 47] as reference number implying any location on the list at the depository on the remote site processor).

As per claims 4 and 5, Buchanan discloses that the first institution comprises a financial institution or a bank (**col.7, Fig.1**; via a bank of first deposit **101**).

As per claims 6, 7 and 8, Buchanan discloses transmitting the electronic package to a second institution wherein the second institution comprises a clearing institution and wherein the clearing institution comprises a reserve institution for recovery of the funds (**col.8**, lines 26-31and **Fig.2**; via Maker bank [2nd institution] site with **FRB 107**).

As per claim 9, *Buchanan* discloses that the second institution comprises a drawee financial institution that is identified from the electronic package (**col.3**, lines 4-22; via complete deposit data [electronic package] used by central site of collection center for deposit from other institutions [maker bank - 2nd institution]).

As per claim 10, *Buchanan* discloses the first institution comprises a clearing institution (**Fig.2**, maker bank site **199** with **107**).

A per claim 11, *Buchanan* further discloses the method, wherein crediting the presenter comprises provisionally crediting an account of the presenter and releasing the credited funds after recovery of the funds (**col.3**, lines 42-57; via the system includes ... methodology that enables individuals ... to capture ... deposit information ... for the purpose of having those checks credited to the depositing individual's bank account ... entered into the bank check clearing channels for ultimate delivery to the maker bank for payment out of the maker's account implied releasing after recovery of the fund).

A per claim 12-13, *Buchanan* discloses the first institution comprises a drawee financial institution identified by the financial instrument and the presenter comprises a clearing institution (**col.7**, lines 11-32; via a bank of first deposit **101** deceives a check from the bearer [presenter] information includes maker bank account number and through **FB** check clearing processes).

As per claim 14, *Buchanan* discloses the image is encrypted, the method further comprises decrypting the image (**col.32-45**; via check images stored and encryption to ensure privacy).

As per claims 15-16, *Buchanan* discloses that the financial instrument comprises a check and a credit-card sales slip (**col.1**, lines 24-25; via the act of depositing or otherwise converting a financial instrument such as a check, draft, or other instrument [such as credit-card sales slip] has generally required the physical presentment of the instrument and **col.2**, lines, 44-45; via checks and deposit records or electronic information without the use of paper items).

As per claims 30 and 34, *Buchanan* discloses a computer-readable storage medium having a computer-readable program embodied therein for directing operation of a computer system for a first institution (**Fig.1**, a bank of first deposit **101**), the computer system including a communications system, a processor, and a storage device, wherein the computer-readable program includes instructions for operating the computer system to process a financial instrument (**col.5 & 6**, lines 50-67 and 1-65 respectively) in accordance with the following:

crediting an account of the presenter for funds in accordance with the financial instrument (**col.3**, lines 50-55; credited to the depositing individual's account inherently after recovery of funds to change provisional).

Buchanan fails to disclose explicitly the step of receiving an electronic package defining an image of the financial instrument at a first institution from a presenter, the image having been generated as part of a transaction at a point of sale.

However, ***Anderson*** being in the same field of invention discloses the step of receiving an electronic package defining an image of the financial instrument at a first institution from a presenter, the image having been generated as part of a transaction at

a point of sale (**para 0039-0043** and specifically **para 0042**, line 1+ point of sale [POS] devices allow an individual to conduct transaction and **para 0043**, lines 1+; via Check imaging ... banking institution).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the features and disclosures of **Buchanan** to include the disclosures of **Anderson** to facilitate the Electronic Check Presentment[ECP] without routing paper checks at **POS** devices.

As per claims 31 and 35, Buchanan discloses the computer-readable program further includes instructions for transmitting the image of the financial instrument to a second institution for recovery of the funds (**col.6**, lines 1-2 and **col.7**, lines 10-32; via computer readable media and step **118** into a maker bank **108** for collection of funds).

Claims 32 and 36, are rejected as per the reasons set forth in **claim 3**

Claims 33 and 38, are rejected as per the reasons set forth in **claim 15**

As per claim 37, Buchanan discloses the financial instrument is adopted for connection with the Internet (**col.2**, lines 32-3; via financial institution over telecommunication lines such as Internet etc.).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HATEM ALI whose telephone number is (571)270-3021. The examiner can normally be reached on 8.00 to 6.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harish Dass/
Primary Examiner

Hatem Ali
Examiner
Art Unit 3692